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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BLACKWELL, JAMES H

ART UNIT PAPER NUMBER

2176

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,116

Applicant(s)

CHERRY ET AL.

Examiner

James H Blackwell

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 7-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This Office Action is in response to Amendment, filed 03/10/2005.
2. Claims 1, 3, and 7-23 remain pending. The Applicant has canceled claims 2, and 4-6.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 9-10, 12, 13-15, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent No. 5,860,362) in view of Grobler (U.S. Patent No. 6,799,084).

In regard to independent Claim 1, Smith teaches the following limitations: *said media selection interface including: a memory for storing media data (Col. 2, lines 51-54); a printer device for printing said hardcopy of said media request (Col. 2, lines 24-28); an input device for retrieving information from a user (Col. 3, lines 9-10); a display device for displaying lists of available media selections and input options (Col. 3, lines 3-13); at least one communications port for communicating with a remote device (Col. 2, lines 45-49); a central processing unit for communicating with said memory, said printer device, said input device, said display device, and said at least one communications port (Col. 2, lines 51-52) and; a service provider for communicating with said central processing unit through said at least one communications port for receiving said*

information from a user and providing media in a data format to said media selection interface (Col. 2, lines 45-49), said service provider including.

Smith does not teach the specifics of the service provider. However, Grobler teaches *a computer for communicating with said central processing unit* in the form of a data depot that may include a computer located at a remote location on which data to be vended is stored or from which data to be vended is routed (Col. 2, lines 25-27). Grobler also teaches *at least one user profile database for storing demographic information about users of said personalized media service device received from said central processing unit, said stored demographic information about a user in said user profile database comprising information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences* in that the data on the data depot (12) includes a database (40) which maintains owner and/or possessor records for each said data carrier (30), the data being selected from the group including ownership or possession history of the data carrier, personal details of the past and present owner and/or possessor of the data carrier, *demographic* data about the user/owner of the data carrier, data recorded onto the data carrier at an authorized data dispensing device (either cumulatively or periodically, by title, by artist, etc), data rented and the rental period (either cumulatively or periodically, by title, by artist, etc), the user's normal requirements, the user's payment records, royalties paid to the copyright owner by the user, and favorite data of the user (*user preferences*) (Col. 4, lines 11-23). It would have been obvious to one of ordinary skill in the art at the time of

invention to combine the teachings of Smith and Grobler as both inventions relate to the dispersal of personalized media through a “vending machine” like means. Adding the teaching of Grobler provides the benefit of associating demographic information with media content to enable tracking of any illegal copies of the media made by the purchaser of the media.

Smith also fails to explicitly teach the existence of *at least one database of available media selections and corresponding media selection retrieval information for providing media in said data format to said central processing unit*. However, Grobler teaches such a limitation in that a database exists on the data depot that contains data recorded onto a data carrier and other information (Col. 4, lines 11-23). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Grobler as both inventions relate to the dispersal of personalized media through a “vending machine” like means. Adding the teaching of Grobler provides the benefit of storing desired information with media content to output to media after the purchase of such information stored on said media by a consumer.

In regard to dependent Claim 3, Smith teaches *media stored in a data format in said memory for retrieval by said central processing unit and printing by said printer device* in that a ROM (42) and a RAM (44) for storing the information received from the news providing organization (38) (Col. 2, lines 51-54).

In regard to dependent Claim 9, Smith teaches an authentication device for communicating with said central processing unit for identifying a user of said personalized media service in that a card inserted into the card reader (52) may be of a

type similar to a phone card which is purchased elsewhere and has a fixed number of units, initially stored on it. As purchases are made, the units stored on the card are reduced. If the card is of a type that needs connection to a banking system, this can be done via a modem connected to the PSTN. Connection to the PSTN allows access to the Internet. The self-service vending machine (2) can have the facility for credit card transactions to be transacted over the Internet (Col. 3, lines 23-32). Hence, transactions with the card would necessarily be authenticated before actions took place.

In regard to independent Claim 10, Claim 10 reflects the personalized media service device for producing media on demand ..., as claimed in Claim 1, and is rejected along the same rationale

In addition, Smith teaches *providing the user a menu of available media selections for choosing a desired media selection for creation; identifying a media selection made by the user* (Col. 2, lines 10-17).

Smith also teaches *retrieving a data format copy of said media selection; and printing a hardcopy of said media selection from said data format copy of said media selection* (Col. 3, lines 17-22).

In regard to dependent Claim 12, Claim 12 reflects the method of creating a hardcopy media selection for a user as claimed in Claim 10, and is rejected along the same rationale.

In regard to dependent Claim 13, Smith does not explicitly teach *establishing a connection between a computer and a service provider using the Internet*. However,

Smith does teach an on-line connection through a network (Col. 2, lines 45-49). It would have been obvious to one of ordinary skill in the art at the time of invention to conclude that an on-line connection was established, the Internet being one of many such protocols for doing so, allowing for access to the media information to the vending machine.

Smith also teaches *linking said computer to a menu page stored in a memory of said service provider; retrieving a list of available media selections from said memory of said service provider; displaying said list of available media selections on said menu page linked to said computer; and prompting said user to choose one of said available media selections* in that news items are received from an on-line connection, which update news items previously stored. The vending machine interface can receive an input indicating at least one news item required; displaying the relevant cost; checking and accepting any payment made; printing the indicated at least one news item; and delivering the at least one printed news item to a customer (Col. 1, lines 51-59).

In regard to independent Claim 14, Claim 14 reflects the method of creating a hardcopy media selection for a user as claimed in Claim 10 and is rejected along the same rationale.

In regard to dependent Claim 15, Smith teaches *printing a hardcopy of said electronic copy of media associated with said media request on said printer device of said media selection interface* in that a printer (12) that prints the whole newspaper or the part of the newspaper requested. The printed sheet or sheets are taken by a feeder

(18b) (Fig. 2) to an opening (20) in the housing (4) for collection by the customer (Col. 2, lines 24-28).

In regard to dependent Claim 17, Smith teaches displaying the relevant cost (*displaying the total cost of said media request on said display device of said media selection interface*); checking and accepting any payment made (*prompting said user to make a payment for said media request; and verifying payment of said payment for said media request before*); printing the indicated at least one news item; and delivering the at least one printed news item to a customer (Col. 1, lines 57-60 (*communicating said media request to said service provider*)).

In regard to dependent Claim 18, Claim 18 reflects the method of creating a hardcopy media selection for a user as claimed in Claim 9, and is rejected along the same rationale.

In regard to dependent Claim 19, Smith teaches *debiting a user's account for the cost of said media request following said printing of said hardcopy of said media request* in that the newspaper can be purchased by either inserting a banking or credit card in a card reader (52) or inserting coins into a coin slot (50). The vending machine (2) would then print out the up to the minute news requested (see Abstract).

5. Claims 7-8, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Grobler and in further view of Nozue et al. (hereinafter Nozue, U.S. Patent No. 5,845,262).

In regard to dependent Claims 7 and 8, neither Smith nor Grobler specifically teach *at least one content provider in communication with said service provider for providing media in said data format to said service provider in response to said retrieved information and said at least one content provider comprises a media publisher computer for storing and transmitting said media in said data format to said service provider*. However, Nozue teaches that the producing system (1) is constructed by a publisher (10) and an electronic press information producer (20). Further, the publisher (10) is divided into a newspaper company (11) (*content provider*), a publishing company (13) (*service provider*), and a small-scale publishing company (15) (*service provider*) (Col. 5, lines 45-49; Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith, Grobler, and Nozue because all three inventions relate to customizing information content for purchase. Nozue adds the benefit of a network of information providers and producers to provide the content for selection and purchase.

In regard to dependent Claim 16, both Smith and Grobler's teachings are limited to newspaper, and audio/video/software and information (text) distribution via vending machine. However, Nozue teaches a system for mainly transferring various information of a newspaper, a magazine, an advertisement, and the like by dot data. Data information provided from a newspaper company, publishing companies, and the like is converted into electronic press information via an electronic press producer (20). The electronic press information is dispatched from a center to an information vending machine through a satellite line or a terrestrial line (see Abstract) (*retrieving a list of*

newspapers and magazines available to said media selection interface from said service provider). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith, Grobler, and Nozue as all three inventions relate to providing a variety of information to users through a network. Nozue adds the benefit of expanding the notion of the vending machine to a home user.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Grobler, and in further view of Leeke et al. (hereinafter Leeke, U.S. Patent No. 6,587,127).

In regard to dependent Claim 11, neither Smith nor Grobler specifically teach a *user interface with a touch screen display*. However, Leeke teaches an input device (124) that can include a keyboard, a pointing device, and/or a touch screen for receiving user-initiated events, actions, and selections from an end user (Col. 4, lines 37-40). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith, Grobler, and Leeke as both inventions relate to generating selected content initiated through a user interface. Leeke provides the benefit of incorporating a keyboard into a touch screen that can also simultaneously display content selections.

7. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Leeke and in further view of Miyasaka et al. (hereinafter Miyasaka, U.S. Patent No. 6,766,362).

In regard to dependent Claim 20, Smith fails to teach *querying said determined content provider for said electronic copy of media associated with said media request; including said set of user preferences with said query; and creating a customized electronic copy of media associated with said media request based upon said set of user preferences*. However, Miyasaka teaches that a computer network server provides a customized newspaper to a recipient according to recipient profile preferences. The server searches for and obtains article content that is deemed to be of greatest interest to the recipient according to topical preferences, generates a representation of the selected content according to a layout preference, and delivers the representation to the recipient according to a designated schedule. Recipient preferences are received and stored in a profile database using facilities that assist a recipient to specify preferred topics, newspaper layout, delivery schedule and destination. Topical designations are mapped into hierarchical structures that facilitate searching content databases. Newspaper articles are arranged according to relative priorities of designated topics (see Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Miyasaka because both deal with obtaining customized news content. Miyasaka provides the benefit of using a provided user profile in the search, retrieval, and construction of content for the user.

In regard to dependent Claim 21, Smith fails to teach *displaying a user log-in request on said display device of said media selection interface; prompting said user to enter log-in information using said input device of said media selection interface; communicating said log-in information to said service provider using said at least one*

communications port; comparing said log-in information to at least one user profile database accessible to said service provider to determine an identity of said user; authorizing use of the media selection interface when said identity of said user is determined; and prompting said user to register a user profile in said user profile database if said identity of said user is not determined and authorizing use of the media selection interface following completion of said registration of said user profile.

However, Miyasaka teaches a news server (5) requires an individual to setup a subscription by registering individual information in profile database (42). The form shown in Fig. 5A is one example that allows an individual to register for a new subscription (*displaying a user log-in request on said display device of said media selection interface and prompting said user to enter log-in information using said input device of said media selection interface*), or to review and modify current preferences for an existing subscription (Col. 4, lines 33-37). Forms are presented on the screen of display device (26) that guide and assist an individual in using input device (24) to enter and submit information (*communicating said log-in information to said service provider using said at least one communications port*).

Miyasaka also teaches that individuals having an existing subscription may review current preferences by entering a "user id" and an associated "password" in the spaces provided and then "clicking" on the "Go" button with a pointing device such as a mouse. In response, news server (5) returns a form such as that shown in Fig. 5G, which gives a registered individual an opportunity to review and modify current preferences (*comparing said log-in information to at least one user profile database*

accessible to said service provider to determine an identity of said user and authorizing use of the media selection interface when said identity of said user is determined) (Col. 4, lines 49-55).

Miyasaka also teaches that individuals who wish to register for a new subscription may indicate this by clicking on the "Start" button. In response, news server (5) returns one or more forms that allow the individual to enter personal preferences. Examples are shown in Figs. 5B to 5G (*prompting said user to register a user profile in said user profile database if said identity of said user is not determined and authorizing use of the media selection interface following completion of said registration of said user profile*) (Col. 4, lines 57-61). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Miyasaka because both inventions relate to subscribing to online systems using preferences to obtain personalized news materials. Miyasaka adds the benefit of an explicit user interface to ensure that an individual and their preferences and profile are recognized.

In regard to dependent Claims 22 and 23, Claims 22 and 23 reflect the method of creating a hardcopy media selection made by a user as claimed in Claim 21, and is rejected along the same rationale.

Response to Arguments

9. Applicant's arguments with respect to claims 1-3, and 7-23 have been considered but are moot in view of the new ground(s) of rejection.

In regard to independent Claim 10, Applicants argues that Smith does not teach or suggests the element of the claimed invention calling for providing at least one user profile database for storing demographic information about users of a personalized media service, said stored demographic information about a user in said user profile database comprising information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences.

The Examiner agrees and withdraws the rejection. However, the Examiner now introduces the prior art of Grobler, which teaches a profile database containing demographic information including user preferences.

The Applicants also argues that Smith does not teach the limitation in Claim 1 that *at least one database of available media selections and corresponding media selection retrieval information for providing media in said data format to said central processing unit*. The Examiner agrees. However, the Examiner now introduces the prior art of Grobler, which teaches a data depot for storing one or more data types selected from the group comprising digitized or analog music, video, games, information, and computer programs. Grobler also teaches a data-dispensing device in communication with the data depot, and a uniquely identifiable recordable data carrier configured for recording data from the data-dispensing device

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
07/20/05

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
7/25/2005